REMARKS/ARGUMENTS

In the Office Action dated January 6, 2011 (hereinafter, "Office Action"), claims 1–4, 6–11, 13–21 and 23–30 were rejected under 35 U.S.C. § 103(a). By this paper, claims 1, 10–11, 16–17, 27 and 30 are being amended. Claims 31–33 are being added.

Applicant respectfully responds to the Office Action.

I. Claims 1–3, 6, 11, 14–20, 23 and 25–27 Rejected Under 35 U.S.C. § 103(a)

Claims 1–3, 6, 11, 14–20, 23 and 25–27 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,466,329 to Mukai (hereinafter, "Mukai") in view of U.S. Patent No. 6,424,429 to Takahashi et al. (hereinafter, "Takahashi"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17–18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada & Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Int'l Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)).

Claim 1 recites, "A method for providing page description language ("PDL") encapsulated image data from an imaging device that includes a scanner." Claim 1 also recites: "obtaining document formatting inputs for the scan job from a user interface…" By this paper, claim 1 is being amended to recite, "wherein the document formatting inputs comprise copy function options *and scan function options* usable with the scan job." (Emphasis added.) Further, claim 1 recites: "encapsulating the scanned image data in a page description language using the document formatting inputs for document formatting…" By this paper, claim 1 is being amended to recite, "wherein: … the page description language comprises page properties and one or more drawing elements, the one

or more drawing elements comprise drawing element attributes, the drawing element attributes are determined by the scan function options, the scanned image data is encapsulated initially according to page properties ... and the page properties are modified in accordance with the copy function options." Support for the subject matter of these amendments is provided by at least Figures 5–7; paragraphs [54], [56] and [61]–[77]; and original claims 10, 16 and 27 of the pending application.

Applicant respectfully submits that the combination of Mukai and Takahashi does not teach or suggest the subject matter of amended claim 1.

Mukai teaches a multifunction peripheral (MFP) that uses page identification indicia to identify a document being scanned or copied. The identification allows the MFP to retrieve the original document from a database and thereby print or send the document without any degradation in quality that could result from copying or scanning. (See Mukai, col. 5, line 64–col. 6, line 63.) The MFP contains a "document file sender 84 ... for transferring a document file to a computer system (e.g., a database server) on the network through the bidirectional network interface 600 (output part 62)." (Id., col. 9, lines 21–24.) "A document file for transmission either has been stored on the hard disk 90, as in the case of the facsimile data, or is read by the digital scanner 400 from a document to be filed." (Id., col. 9, lines 24–27.) "In the former case, the document file sender 84 may simply deliver the facsimile data read from the hard disk 90 to the output part 62 unchanged because the facsimile data are in PDL format, which is transferrable on-line." (Id., col. 9, lines 27–31.) "In the latter case, the scanned image of the document to be filed is delivered to the document file sender 84 after it has been developed into a bitmap in the image processor 32 and enclosed in PDL format by the image PDL processor 85." (Id., col. 9, lines 31–35.)

As relevant to the Office Action, Takahashi teaches a copying machine 11 that has options to control the page orientation, page margins, and page size.

As best understood, the Office Action treats Mukai enclosing a scanned document image in PDL format like claim 1's "encapsulating the scanned image data in a page description language." Further, as best understood, the Office Action treats Takahashi's copy machine options like claim 1's copy function options. Even assuming the Office Action is correct (which Applicant does not

concede), the combination of Mukai and Takahashi still does not teach or suggest all of the subject matter of amended claim 1.

Amended claim 1 recites that the "document formatting inputs comprise copy function options and scan function options." It also recites that the "page description language comprises page properties and one or more drawing elements," and that "the one or more drawing elements comprise drawing element attributes." Lastly, it recites that "the drawing element attributes are determined by the scan function options," "the scanned image data is encapsulated initially according to page properties determined by the scanner," and "the page properties are modified in accordance with the copy function options."

The combination of Mukai and Takahashi does not teach or suggest this subject matter. First, although the combination of Mukai and Takahashi teaches that a scanned document image may be enclosed in PDL, it does not provide any specific details regarding the structure of the PDL. Amended claim 1, on the other hand, recites that the page description language comprises page properties and one or more drawing elements. It also recites that the one or more drawing elements comprise drawing element attributes. Second, the combination of Mukai and Takahashi does not teach or suggest how the copy function options are used to enclose the PDL. In contrast, amended claim 1 explains that "the drawing element attributes are determined by the scan function options." It also explains that "the scanned image data is encapsulated initially according to page properties determined by the scanner," and then "the page properties are modified in accordance with the copy function options." Accordingly, Applicant respectfully submits that the combination of Mukai and Takahashi does not teach or suggest all of the subject matter of amended claim 1.

For at least the foregoing reasons, Applicant respectfully submits that amended claim 1 is allowable. Claims 2–3, 6 and 10 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Amended claim 11 recites, "wherein the document formatting inputs comprise copy function options and scan function options usable with the scan job." Amended claim 11 also recites, "encapsulate the scanned image data in a page description language using the document formatting

inputs for document formatting, wherein: the encapsulating occurs at the imaging device, the page description language comprises page properties and one or more drawing elements, the one or more drawing elements comprise drawing element attributes, the drawing element attributes are determined by the scan function options, the document formatting inputs control how the scanned image data is framed into a document defined by the page description language, the scanned image data is encapsulated initially according to page properties determined by the scanner, the page properties of the page description language of the scanned image data are modified in accordance with the document formatting inputs copy function options." As discussed above, the combination of Mukai and Takahashi does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that amended claim 11 is allowable. Claims 14–16 depend from claim 11, and are therefore allowable for at least the same reasons as claim 11.

Amended claim 17 recites "wherein the document formatting inputs comprise copy function options and scan function options usable with the scan job." Amended claim 17 also recites, "encapsulate the scanned image data in a page description language using the document formatting inputs for document formatting, wherein: the encapsulating occurs at the imaging device, the page description language comprises page properties and one or more drawing elements, the one or more drawing elements comprise drawing element attributes, the drawing element attributes are determined by the scan function options, the document formatting inputs control how the scanned image data is framed into a document defined by the page description language, the scanned image data is encapsulated initially according to page properties determined by the scanner, the page properties of the page description language of the scanned image data are modified in accordance with the document formatting inputs copy function options." As discussed above, the combination of Mukai and Takahashi does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that amended claim 17 is allowable. Claims 18–20, 23 and 25–27 depend from claim 17, and are therefore allowable for at least the same reasons as claim 17.

II.   Claims 4 and 21 Rejected Under 35 U.S.C. § 103(a)

Claims 4 and 21 stand rejected under 35 U.S.C. § 103(a) based on Mukai in view of Takahashi and further in view of U.S. Patent Application Publication No. 2002/0114021 to Lavender et al. (hereinafter, "Lavender"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a prima facie case of obviousness is provided above.

Claim 4 depends from claim 1. Claim 21 depends from claim 17. As discussed above, Applicant respectfully submits that claims 1 and 17 are allowable. Accordingly, Applicant respectfully submits that claims 4 and 21 are allowable for at least the same reasons as presented above in connection with claims 1 and 17, respectively.

III.   Claims 7–10, 13, 24 and 28 Rejected Under 35 U.S.C. § 103(a)

Claims 7–10, 13, 24 and 28 stand rejected under 35 U.S.C. § 103(a) based on Mukai in view of Takahashi and further in view of U.S. Patent No. 5,493,634 to Bonk et al. (hereinafter, "Bonk"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a prima facie case of obviousness is provided above.

Claims 7–10 and 28 depend from claim 1. Claim 13 depends from claim 11. Claim 24 depends from claim 17. As discussed above, Applicant respectfully submits that claims 1, 11 and 17 are allowable. Accordingly, Applicant respectfully submits that claims 7–10, 13, 24 and 28 are allowable for at least the same reasons as presented above in connection with claims 1, 11 and 17, respectively.

IV.   Claims 29 and 30 Rejected Under 35 U.S.C. § 103(a)

Claims 29 and 30 stand rejected under 35 U.S.C. § 103(a) based on Mukai in view of Takahashi and Bonk and further in view of U.S. Patent Application Publication No. 2003/0007177 to

Ferlitsch (hereinafter, "Ferlitsch"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a prima facie case of obviousness is provided above.

Claims 29 and 30 depend from claim 1. As discussed above, Applicant respectfully submits that claim 1 is allowable. Accordingly, Applicant respectfully submits that claims 29 and 30 are allowable for at least the same reasons as presented above in connection with claim 1.

V. New Claims 31–33

By this paper, claims 31–33 are being added. Support for the subject matter of claims 31–33 is provided by at least Figures 5–7, and paragraphs [70]–[71] and [74]–[75] of the pending application. Claims 31–33 depend directly or indirectly from claim 1. They are therefore allowable for at least the same reasons as claim 1.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that all pending claims in the present application are in a condition for allowance, which is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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